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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,739	09/30/2003	William T. Ball	P06474US2	3981
34082	7590	09/30/2005	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			PRUNNER, KATHLEEN J	
		ART UNIT		PAPER NUMBER
				3751

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/674,739	BALL, WILLIAM T.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kathleen J. Prunner	3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 December 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1 and 2 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 30 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Reopening Prosecution***

1. In view of the appeal brief filed on December 27, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, (A) the "drain pipe having an inverted L-shape", as called for by claim 1; (B) the "drain pipe ... including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system", as called for by claim 1; (C) a "fluid drain system", as called for by claim 1; and (D) "an overflow pipe having a first exposed end and [a] second end in communication with a fluid source", as called for by claim 2, must be shown or the features canceled from the claims. No new matter should be entered.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

### *Specification*

5. The specification is objected to as failing to provide proper antecedent basis for the claimed terminology. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claim terminology which lacks such antecedent basis is as follows: (A) "An overflow system for a bathtub", as called for by claim 1; (B) the "drain pipe having an inverted L-shape", as called for by claim 1; (C) the "drain pipe ... including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system", as called for by claim 1; (D) the "fluid drain system", as called for by claim 1; (E) "a solid cap", as called for by claims 1 and 2; (F) "a solid cap threaded into interior threads of the horizontal leg extending through the overflow port to close the end of the horizontal leg", as called for by claim 1; (G) "A plumbing test system", as called for by claim 2; (H) "an overflow pipe having a first

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exposed end and [a] second end in communication with a fluid source", as called for by claim 2; (I) "a fluid source", as called for by claim 2; and (J) "wherein a portion of the cap is composed of a material capable of sealing the first end when the cap is threaded onto the first end", as called for by claim 2.

6. The following informalities in the claims are noted: (A) in claim 2, on line 2, --a-- should be inserted after "and".

#### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 2 calls for "a solid cap" wherein "the cap is composed of a material capable of sealing the first end when the cap is threaded onto the first end". However, the originally filed disclosure fails to describe or support that the cap "is composed of a material capable of sealing the first end when the cap is threaded onto the first end". Additionally, the originally filed disclosure fails to describe or support what type of material is capable of forming a cap and yet be "capable of sealing". Hence the originally filed disclosure is insufficient to permit the person skilled in the art to make and use the claimed invention without undue experimentation.

#### *Double Patenting Rejection*

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/247,247. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim substantially the same invention. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/247,247. For double patenting to exist as between the rejected claim 1 and claim 1 of copending Application No. 10/247,247, it must be determined that the rejected claim is not patentably distinct from claim 1 of the copending application. In order to make this determination, it first must be determined whether there are any differences between the rejected claim 1 and claim 1 of the copending application and, if so, whether those differences render the claim patentably distinct.

Claim 1 recites (a) "an overflow system for a bathtub which has a bottom, and adjacent side and endwalls, a drain port in the bottom, and overflow port in an endwall" (note lines 1-3 of the copending application); (b) "a drain pipe adapted to be in communication with the drain port and the overflow port" (note lines 6-7 of the copending application); (c) "the drain pipe having an inverted L-shape including a horizontal leg extending into and through the overflow part of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system" (note lines 8-11 of the copending application); and (d) [a] "cap threaded into the horizontal leg extending through the overflow port to close the end of the horizontal leg" (note lines 14-18 of

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the copending application). Claim 1 further recites that the threaded cap is “solid” and is threaded “into interior threads of the horizontal leg”. Claim 1 of the copending application anticipates the solid cap of claim 1 of the application with the language “a cap of one-piece construction” (note line 14 of the copending application) and its disclosure of a “solid cap” (note line 30 on page 2 and Figs. 4 and 7-10). Similarly, Claim 1 of the copending application anticipates the cap being threaded “into interior threads of the horizontal leg” of claim 1 of the application with the language “a cap ... threadably mounted on an end of the horizontal leg” (note lines 14-15 of the copending application) and its disclosure of “a solid plug screwed into a threaded interior of the outer end of the drain pipe” (note lines 34-35 on page 2 and Figs. 9 and 10).

It is clear that all the elements of claim 1 are to be found in claim 1 of the copending application. The difference between claim 1 of the application and claim 1 of the copending application lies in the fact that the copending application includes more elements and is thus more specific. Thus the invention of claim 1 of the application is in effect a “species” of the “generic” invention of claim 1 of the copending application. It has been held that the generic invention is anticipated by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 1 of the application is anticipated by claim 1 of the copending application, it is not patentably distinct from claim 1 of the copending application.

#### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oropallo et al. in view of Altman et al.

With respect to claim 1, Oropallo et al. disclose an overflow system for a bathtub (note Fig. 1) which has a bottom 19, adjacent side walls and end walls 13, a drain port 18 in the bottom 19, and an overflow port 12 in one of the end walls, the overflow system having the claimed features including a drain pipe (note lines 54-58 in col. 2) adapted to be in communication with the drain port 18 and the overflow port 12 (note Fig. 1), the drain pipe having an inverted L-shape (note Fig. 1) including a horizontal leg 11 extending into and through the overflow port 12 of the bathtub (note Figs. 3 and 13) and a vertical leg 16 extending downwardly for connection to a fluid drain system (note Fig. 1), and a solid cap 40 (note Fig. 13) threaded onto exterior threads of the horizontal leg 11 (note Fig. 13) extending through the overflow port 12 to close the end of the horizontal leg 11 (note Fig. 13). Although Oropallo et al. disclose that the horizontal leg 11 of the overflow drain pipe is externally threaded and fail to teach the use of other attachment devices that are an alternative to the internally threaded cap to the externally threaded pipe, attention is directed to Altman et al. who disclose another bathtub 12 (note lines 6-8 in col. 1) having a pipe 360 that includes a horizontal leg or end 362 extending to a port in the bathtub 12 (note Fig. 2), the horizontal leg or end 362 being closed by a one-piece constructed cap (constituted by the portion 370, note Fig. 2) that is threaded into interior threads of the horizontal leg 362 of the pipe 360 to close the end of the horizontal leg 362 (note Fig. 2). It would have been obvious to one of ordinary skill in the bathtub art, at the time the invention was made, to employ an internally threaded pipe that engages an externally threaded cap in Oropallo et al. especially in view of the teachings of Altman et al. to secure the cap to the pipe wherein so doing would involve mere substitution of one well known securing mechanism for another within the bathtub art.

With respect to claim 2, Oropallo et al. also disclose a plumbing test system including an overflow pipe 11 having a first exposed end (note Fig. 13) and a second end in communication with a fluid source (note lines 34-50 in col. 3) wherein the first end comprises an externally threaded portion 41 and a solid cap 40 threadably mounted to the first end (note Fig. 13) and wherein a portion of the solid cap 40 (constituted by annular seal 42) is composed of a material

capable of sealing the first end when the cap is threaded to the first end (note lines 36-39 in col. 3). Although Oropallo et al. disclose that the horizontal leg 11 of the overflow drain pipe is externally threaded and fail to teach the use of other attachment devices that are an alternative to the internally threaded cap to the externally threaded pipe, attention is directed to Altman et al. who disclose another bathtub 12 (note lines 6-8 in col. 1) having a pipe 360 that includes a horizontal leg or end 362 extending to a port in the bathtub 12 (note Fig. 2), the horizontal leg or end 362 being closed by a one-piece constructed cap (constituted by the portion 370, note Fig. 2) that is threaded into interior threads of the horizontal leg 362 of the pipe 360 to close the end of the horizontal leg 362 (note Fig. 2). It would have been obvious to one of ordinary skill in the bathtub art, at the time the invention was made, to employ an internally threaded pipe that engages an externally threaded cap in Oropallo et al. especially in view of the teachings of Altman et al. to secure the cap to the pipe wherein so doing would involve mere substitution of one well known securing mechanism for another within the bathtub art.

#### *Response to Arguments*

12. Applicant's arguments filed December 27, 2004 have been fully considered but they are not deemed persuasive.

13. In response to applicant's arguments that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

14. Applicant's arguments with respect to the evidence of suggestion, teaching or motivation to combine the references to make out a *prima facie* case of obviousness have been carefully considered. However, the *prima facie* case is one of equivalence wherein the prior art element

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performs the identical function specified in the claims in substantially the same way and produces the same results as the corresponding element disclosed in the specification, a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification, there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification, and the prior art is a structural equivalent of the corresponding element disclosed in the specification. See M.P.E.P. § 2183.

### *Conclusion*

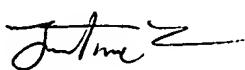
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Kathleen J. Prunner, whose telephone number is 571-272-4894.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu, can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kathleen J. Prunner

September 26, 2005

  
JUSTINE R. YU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

9/28/05